

Serial No.: 10/084,844

Filing Date: February 25, 2002

Title: Methods for Providing Extended Dynamic Range in Analyte Assays

REMARKS/ARGUMENTS

I. CLAIM AMENDMENTS

Without acquiescing to the rejections in the Office Action of December 19, 2005, Applicants have amended claims 4, 18, 35 and 38 for a variety of reasons. Claim 4 has been amended to better capture the envisioned commercial embodiments. For example, claim 4 has been amended to recite that the conversion factor of the optical filter is predetermined. Support for the claim amendments can be found throughout the specification. Specifically, support for the amendments to claim 4 can be found in at least paragraphs 0474, 0476 and 0480 of U.S. Pregrant Publication No. 2003/0096302. The amendments to claims 18, 35 and 38 correct typographical errors or clarify antecedent basis. Accordingly, no new matter has been introduced by way of these amendments.

II. THE OFFICE ACTION OF DECEMBER 19, 2006

A. THE REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH, ARE MOOT

The Office Action of December 19, 2006 rejected claims 4, 16-20, 27-36 and 38 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for “failing to point out and distinctly claim the subject matter which applicant regards as his invention.” *Office Action of December 19, 2005*, page 2. The amendments to claims 4 and 38 render moot the indefiniteness rejections. Withdrawal of these rejections is earnestly solicited.

B. THE REJECTIONS UNDER 35 U.S.C. §103 ARE MOOT

1. Phillips and Chenchik

The Office Action of December 19, 2005 rejected claims 4, 18, 31-36 and 38 under 35 U.S.C. §103 as allegedly being “unpatentable over Phillips et al. (US 6,171,793) in view of Chenchik et al. (US 6,287,768).” *Office Action of December 19, 2005*, page 3. Without agreeing with the assertions made in the December 19th Office Action, Applicants have amended

Serial No.: 10/084,844

Filing Date: February 25, 2002

Title: Methods for Providing Extended Dynamic Range in Analyte Assays

independent claim 4 to better capture the envisioned commercial embodiments. The amendments to the independent claims, which flow through to their dependent claims, render moot the rejections under 35 U.S.C. §103.

Specifically, the amended claims recite that the conversion factor to be used is predetermined. Neither Phillips nor Chenchik, alone or in combination, teach or suggest that the conversion factor that is used to scale the signal is predetermined. In other words, Phillips teaches that that the “scale factor correlation function *is calculated* between the first data and the second data, and is applied to convert the second data to have the same scale factor as the first data.” *U.S. Patent No. 6,171,793*, col. 4, ll. 55-57 (emphasis added). Indeed, claim 1 of the ‘793 patent (Phillips) indicates that the claimed method requires a calculation step (step c) where a “scale factor correlation function” is calculated between the first and second data. *U.S. Patent No. 6,171,793*, col. 13, ll. 39.

The presently amended claims, however, indicate that the conversion factor is not based upon a correlation between a first and second set of data. Indeed, Phillips requires the generating two separate sets of data to determine the conversion factor, whereas the presently claimed invention does not require generating two data sets to generate the conversion factor. In contrast, the conversion factor of the presently claimed invention is simply applied to a second set of data (light intensity signals). Furthermore, Chenchik does not cure these deficiencies. Thus, the combination of Phillips and Chenchik does not teach or even suggest each and every limitation of the presently claimed invention. Accordingly, the combination of Phillips and Chenchik does not render obvious the presently claimed invention. Withdrawal of the obviousness rejection is earnestly solicited.

2. Phillips, Chenchik and Bartz

The Office Action of December 19, 2005 rejected claims 16, 17, 19, 20, 27, 29 and 30 under 35 U.S.C. §103 as allegedly being “unpatentable over Phillips et al. (US 6,171,793) in

Serial No.: 10/084,844

Filing Date: February 25, 2002

Title: Methods for Providing Extended Dynamic Range in Analyte Assays

view of Chenchik et al. (US 6,287,768) ... and further in view of Bartz (US 5,350,922)." *Office Action of December 19, 2005*, page 6. Without agreeing with the assertions made in the December 19th Office Action, Applicants have amended independent claim 4 to better capture the envisioned commercial embodiments. The amendments to the independent claims, which flow through to their dependent claims, render moot the rejections under 35 U.S.C. §103.

As discussed above, the presently claimed invention does not require generating two separate sets of data to generate the conversion factor, and the combination of Phillips and Chenchik does not teach or suggest the predetermined conversion factor. Further, Bartz does not cure these deficiencies. Withdrawal of the obviousness rejection is earnestly solicited.

CONCLUSION

Claims 4, 18, 35 and 38 have been amended, and the claim amendments do not introduce new matter. Entry of the claim amendments is earnestly solicited. If the claim amendments are entered, Applicants assert that these amendments would render moot the outstanding rejections for the reasons stated above. Entry of the claims amendments and reconsideration of the outstanding rejections are earnestly solicited.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date June 19, 2006

By Todd B. Buck

Castellano Malm Ferrario & Buck PLLC
Customer Number: 57904
Telephone: (202) 478-5300
Facsimile: (202) 318-1288

Todd B. Buck
Registration No. 48,574